

## REMARKS

Favorable reconsideration of this application, as amended, and in light of the following discussion is respectfully requested.

Claims 1, 2, 3, 4-8 and 10-12 are pending in this application. Claims 1, 2, 5, and 8 have been amended and support for these amendments can be found in the claims as originally presented and in the specification. Claim 4 has been canceled. Claim 13 has been added to replace claim 4. This is a restoration of the original claim 4 because the amendment to claim 5 was erroneously referred to as claim 4 in the previous response. No new matter is introduced by this amendment.

### Information Disclosure Statement

The Examiner has indicated that the Information Disclosure Statement filed March 18, 1999, fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance of the two prior presented Japanese technical data sheet.

Applicants take note of the Examiners remarks that these references have been placed in the application file, but the information referred to therein has not been considered.

### In The Abstract

The Examiner asserts that the language of the abstract should be clear and concise avoiding phrases that can be implied. In light of applicants amendment of the abstract, the objection has been overcome and its withdrawal is respectfully requested:

### Rejections under 35 U.S.C. § 112

The Examiner alleges that claims 2 and 8 are not supported by the disclosure of the present application. Applicants have amended claims 2 and 8. The support for claim 2 can be found on page 10, line 23 to page 11, line 4. Additionally, the disclosure to support claim 8 can be found on page 18, lines 9-11. The Examiner's attention is also directed original claims 2 and 8 in which this range appears. Withdrawal of this rejection is respectfully requested.

The Examiner alleges that claims 1, 2, 4-8, 10, and 11 fail to point out and distinctly claim that which the inventor's believe to be their invention. In particular, the Examiner indicates that claim 1 is unclear as to whether applicants are claiming a continuous phase that is a homogenous composite of the inorganic filler and the aliphatic polyester or a continuous aliphatic polyester phase with dispersed inorganic filler. Thus, the Examiner alleges claim 1 fails for indefiniteness as do claims 2, 4-8, 10 and 11 which are dependent thereon. Applicants respectfully traverse this rejection.

Applicants respectfully submit that the meaning of the claim is clear to one of ordinary skill in the art, especially when read in light of the specification. Nevertheless, in order to facilitate prosecution, Applicants have amended the claim in the manner suggested by the Examiner. Accordingly, withdrawal of the objection is respectfully requested.

The Examiner indicates that claim 5 lacks antecedent basis due to an erroneous claim dependency. In particular claim 5 recites "The formed article according to claim 3" and claim 3 was previously canceled. In light of Examiner's remark, Applicants have amended claim 5 to afford proper antecedent basis. Withdrawal of this rejection is earnestly requested.

### Rejections Under 35 U.S.C. § 103(a)

The Examiner suggests that claims 1, 2, 4-6, 8 and 10-12 are rejected under 35 U.S.C. 102 (e) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Obuchi et al. or Tsai et al. The Obuchi reference teaches a variety of articles, including tying material, made from thermoplastic composition comprising a biodegradable resin containing 25-75% of polylactic acid and 25-75% of a butylenes succinate polymer. Obuchi also teaches that the resin further contains 0.1-70 parts of an inorganic filler such as talc. Tsai et al. teach fibers made from a biodegradable resin comprising 0-100% of polylactic acid and 0-100% of a butylenes succinate polymer, where the polymers form separate domains (phases), the polymer in the greater quantity would constitute the continuous phase and the polymer in minimized quantities would constitute the discontinuous phase dispersed within the continuous phase. This rejection is respectfully traversed.

Section 103(a) rejections cannot be properly premised on what the references do not teach, but rather must be premised on what they would have suggested to one of ordinary skill in the art at the time of the invention. Obuchi et al. is silent regarding the diameter of the dispersed component. The lack of specificity of the diameters of the dispersed polylactic acid does not mean that the reference would suggest to one of ordinary skill in the art the specific ally diameters of the dispersed polylactic acid.. As amended, claim 1 specifies a polylactic acid dispersed in the form of particles of a diameter of not more than about 9 $\mu$ m. Modification of the ranges of the specific diameters of the dispersed polylactic acid to encompass those of the present invention are not suggested within the art itself but are instead the result of hindsight. Even though the prior are could be modified, the art must still have suggested the modification for the present invention. None of the cited references suggest the modification for the present

invention. Often times, particularly with the aid of hindsight, the art appears combinable or modifiable in a manner that will yield the claimed invention. That itself will not make the resultant modification obvious, however. The art must still suggest the desirability of the modification. See *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (“The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.”); accord *In re Laskowski*, 871 F.2d at 117, 10 U.S.P.Q.2d at 1398; *In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780, 1783-1784 (Fed. Cir. 1992); see also *In re Mills*, 916, F.2d 680, 682, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990).

The Examiner has stated that Obuchi et al. clearly disclose 75% aliphatic polyester based upon the mixing process. Applicants have reviewed the Obuchi et al reference and it is silent, i.e. would not have suggested the upward 75% aliphatic polyester from the mixing processes disclosed in the prior art (page 8, line 11 of the Office Action). Applicants respectfully request that the Examiner to provide the basis for his claim that the appropriate numeric range is about 75%.

Obuchi et al fails to teach or suggest either the range of aliphatic polyester or the particle diameter of the filler. Tsai et al. fails to remedy any of the noted deficiencies of Obuchi et al.

Further, the Examiner interprets the product of Sowa Highpolymer Co., Ltd., “Bionolle #1020” as butylenes succinate resin comprising 30% talc (page 5, line 15-19 and page 8, lines 5-6 of the Office Action), however, the Examiner is mistaken. The product “Bionolle #1020” is polybutylene succinate itself (see page 34, lines 12-14 of the present specification; col. 17, lines 56-58 of Tsai et al.). In Example 2 of the present specification, a mixture of Bionolle #1020 and talc is used. Thus, the Examiner’s position that the biodegradable resins with the presently

claimed composition are particularly exemplified in example 14 and 15 of Tsai et al is based on the above misunderstanding and contrary to the disclosure of Tsai et al. Applicants respectfully requests withdrawal of rejection.

### Conclusion

In view of the foregoing amendments and remarks, applicants respectfully request reconsideration and the continued examination of this application, and timely allowance of all pending claims.

If there are any additional fees due in connection with the filing of this Amendment, such as fees under 37 C.F.R. §§ 1.16 or 1.17, please charge the fees to our Deposit Account No. 06-0916. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested.

This fee also should be charged to our Deposit Account No. 06-0916. Any overpayment may be credited to Deposit Account No. 06-0916.

Respectfully submitted,

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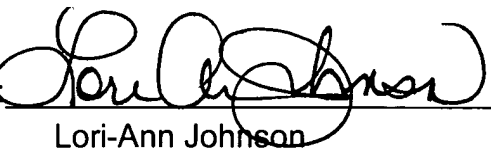
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By:   
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1. Rule 53 (d) CPA transmittal of Serial No. 09/210,539 - 4 pages
2. Preliminary Amendment - 7 pages
3. Post Card